

REMARKS

Claims 1-11 have been examined in the current Office Action, and have been rejected under 35 U.S.C. § 103(a).

I. Preliminary Matters

The Examiner has not acknowledged the drawings filed on July 2, 2001. Accordingly, the Applicant respectfully requests the Examiner to indicate, in the next Office Action, whether the drawings are acceptable.

Also, the Examiner has not acknowledged the claim to foreign priority. Accordingly, Applicant respectfully requests the Examiner to mark, in the next Office Action, the appropriate boxes on the Office Action Summary.

Further, Applicant has amended claims 1, 6, 7 and 11 for clarification and to remove any antecedent basis errors. Such amendments do not narrow the scope of the claims and were not made in view of the prior art.

II. Rejections under 35 U.S.C. § 103(a) in view of U.S. Publication No. 2002/0063723 to Hirono (“Hirono”) in view of U.S. Patent No. 6,360,221 to Gough et al. (“Gough”).

The Examiner has rejected claims 1-5 and 7-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirono in view of Gough.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited references. For example, claim 1 recites that ad information is inserted into an e-mail, where the ad information is retrieved based on area and position information of the e-mail.

The Examiner maintains that Hirono teaches all the features of claim 1, except that Hirono fails to disclose use of an e-mail system. Therefore, the Examiner cites to Gough, which discloses a system for incorporating ad information into e-mails, and maintains that the combination of the cited references suggests the features of claim 1. For the following reasons, Applicant respectfully disagrees.

Hirono discloses a system where a map can be displayed on a home page, and information such as an advertisement can be displayed on the map home page (para. [0040]). A user inputs search parameters of a particular location to a map database 10, and the created map image data is displayed on the map home page (paras. [0047]-[0048]). Advertisement image data is searched and obtained from an advertisement database 12, and placed at a peripheral portion of the map on the map home page (para. [0051]). The advertisement search can be linked to business categories that are relevant to the geographic particulars of the map viewed on the map home page (paras. [0052]-[0053]). In other words, Hirono merely teaches the provision of a map shown on a home page, and possible related advertisements included with the map. The linking of advertisements based on geographic location of a map, which is selected by a user, has no correlation to an e-mail system, or providing an area specific advertisement based on the e-mail terminals.

Gough, on the other hand, discloses an enhanced e-mail system where an e-mail may include an advertisement (col. 5, lines 15-27; col. 6, lines 22-25). However, the inclusion of the advertisement is in no way based on an area or location of either the recipient or sender of the e-mail, nor does Gough ever teach or suggest that a transmitted e-mail is ever detected for area

information. For example, one embodiment of Gough discloses mass advertising e-mail, which is similar to spam e-mail (i.e., there are e-mails sent directly from an advertiser to an e-mail user even though not requested by the e-mail user) (col. 6, lines 18-28). The reference discloses that to avoid actual “spamming”, paid membership service allows for a set mailing list provided to the advertiser (col. 7, lines 1-12). Such set e-mail list will already have a predetermined amount of users, and the users may not all be from the same geographic location. Accordingly, by use of the mailing list, there is never a determination or “detection” of an area information in the e-mail once the e-mail has been sent from the sending terminal, nor will there be placement of an ad based on that area information. Rather, all e-mail accounts on the mailing list will get the advertisement whether or not the advertiser is located in the area of the e-mail users.

In an additional embodiment of Gough, advertising is determined based on how many times an e-mail message has been forwarded. For example, the advertisement is provided with the first electronic message sent, but is not displayed to a user until after a predetermined number of instances of which the e-mail has been forwarded (col. 15, lines 23-41). In such a scenario, users can forward an e-mail message to someone anywhere in the world, and the display of the advertisement would not be based on where (i.e., area information) the message is sent, but by how many times the message was forwarded.

In view of the above, Applicant submits that there is no teaching or suggestion in Gough to include advertisements based on geographic or area information. Further, the Hirono reference is entirely unrelated to a process of sending e-mails or e-mails with advertisements included therein. The geographic information used for map advertisements of Hirono is based

on the actual map data requested by the user (i.e., hotel information provided for the location viewed by the user). The advertisements have no connection to area information of the user itself.

In view of the above, and since Gough fails to teach or suggest that advertisements need to be area specific, Applicant submits that one skilled in the art would not be motivated to modify Gough to arrive at the claimed invention, based on the teachings of Hirono.

Further, as the proffered motivation for modifying the references, the Examiner merely maintains that one skilled in the art would be motivated to incorporate the advertisement containing e-mails into the claimed invention of Hirono, “in order to provide free e-mail services for a member.” (pg. 3 of Office Action). However, the notion of “free” e-mail fails to modify the particular aspects of the e-mail system of Gough at all. Rather, the alleged combination provided by the Examiner is merely a free e-mail system, in addition to the separate use of a program where a user can have a map and advertisements displayed on a home page for a particular area of interest. Such combination fails to teach or suggest the claimed invention. In particular, the Examiner has not provided any reason why, based on the teachings of the cited references, one skilled in the art would be motivated to modify the e-mail system of Gough to provide advertisements based on area information.

In view of the above, Applicant submits that even if taken together, the combined teachings of the references would fail to teach or suggest the claimed invention.

B. Claims 2-5

Since claims 2-5 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claim 7

Applicant submits that method claim 7 is patentable over the cited references. For example, claim 7 recites that ad information is inserted into an e-mail, and the ad information is retrieved based on area and position information of the e-mail.

The Examiner maintains that Hirono teaches all the features of claim 1, except that Hirono fails to disclose use of an e-mail system. Therefore, the Examiner cites to Gough, which discloses a system for incorporating ad information into e-mails, and maintains that the combination of the cited references suggests the features of claim 7. For the following reasons, Applicant respectfully disagrees.

Hirono discloses a system where a map can be displayed on a home page, and information such as an advertisement can be displayed on the map home page (para. [0040]). A user inputs search parameters of a particular location to a map database 10, and the created map image data is displayed on the map home page (paras. [0047]-[0048]). Advertisement image data is searched and obtained from an advertisement database 12, and placed at a peripheral portion of the map on the map home page (para. [0051]). The advertisement search can be linked to business categories that are relevant to the geographic particulars of the map viewed on the map home page (paras. [0052]-[0053]). In other words, Hirono merely teaches the provision

of a map shown on a home page, and possible related advertisements included with the map. The linking of advertisements based on geographic location of a map, which is selected by a user, has no correlation to an e-mail system, or providing an area specific advertisement based on the e-mail terminals.

Gough, on the other hand, discloses an enhanced e-mail system where an e-mail may include an advertisement (col. 5, lines 15-27; col. 6, lines 22-25). However, the inclusion of the advertisement is in no way based on an area or location of either the recipient or sender of the e-mail, nor does Gough ever teach or suggest that a transmitted e-mail is ever detected for area information. For example, one embodiment of Gough discloses mass advertising e-mail, which is similar to spam e-mail (i.e., there are e-mails sent directly from an advertiser to an e-mail user even though not requested by the e-mail user) (col. 6, lines 18-28). The reference discloses that to avoid actual “spamming”, paid membership service allows for a set mailing list provided to the advertiser (col. 7, lines 1-12). Such set e-mail list will already have a predetermined amount of users, and the users may not all be from the same geographic location. Accordingly, by use of the mailing list, there is never a determination or “detection” of an area information in the e-mail once the e-mail has been sent from the sending terminal, nor will there will placement of an ad based on that area information. Rather, all e-mail accounts on the mailing list will get the advertisement whether or not the advertiser is located in the area of the e-mail users.

In an additional embodiment of Gough, advertising is determined based on how many times an e-mail message has been forwarded. For example, the advertisement is provided with the first electronic message sent, but is not displayed to a user until after a predetermined number

of instances of which the e-mail has been forwarded (col. 15, lines 23-41). In such a scenario, users can forward an e-mail message to someone anywhere in the world, and the display of the advertisement would not be based on where (i.e., area information) the message is sent, but by how many times the message was forwarded.

In view of the above, Applicant submits that there is no teaching or suggestion in Gough to include advertisements based on geographic or area information. Further, the Hirono reference is entirely unrelated to a process of sending e-mails or e-mails with advertisements included therein. The geographic information used for map advertisements of Hirono is based on the actual map data requested by the user (i.e., hotel information provided for the location viewed by the user). The advertisements have no connection to area information of the user itself.

In view of the above, and since Gough fails to teach or suggest that advertisements need to be area specific, Applicant submits that one skilled in the art would not be motivated to modify Gough to arrive at the claimed invention, based on the teachings of Hirono.

Further, as the proffered motivation for modifying the references, the Examiner merely maintains that one skilled in the art would be motivated to incorporate the advertisement containing e-mails into the claimed invention of Hirono, “in order to provide free e-mail services for a member.” (pg. 3 of Office Action). However, the notion of “free” e-mail fails to modify the particular aspects of the e-mail system of Gough at all. Rather, the alleged combination provided by the Examiner is merely a free e-mail system, in addition to the separate use of a program where a user can have a map and advertisements displayed on a home page for a particular area

of interest. Such combination fails to teach or suggest the claimed invention. In particular, the Examiner has not provided any reason why, based on the teachings of the cited references, one skilled in the art would be motivated to modify the e-mail system of Gough to provide advertisements based on area information.

In view of the above, Applicant submits that even if taken together, the combined teachings of the references would fail to teach or suggest the claimed invention.

D. Claims 8-10

Since claims 8-10 are dependent upon claim 7, Applicant submits that such claims are patentable at least by virtue of their dependency.

III. Rejections under 35 U.S.C. § 103(a) in view of Hirono, Gough and U.S. Patent No. 6,684,088 to Halahmi (“Halahmi”).

The Examiner has rejected claims 6 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Hirono, Gough and Halahmi. However, since claims 6 and 11 are dependent upon one of claims 1 and 7, and Halahmi fails to cure the deficient teachings of Hirono and Gough, in regard to claims 1 and 7, Applicant submits that claims 6 and 11 are patentable at least by virtue of their dependency.

IV. Newly Added Claims

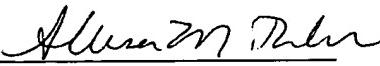
Applicant has added claims 12 and 13 to provide more varied protection for the present invention. Applicant submits that such claims are patentable at least by virtue of their dependency.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Allison M. Tulino
Allison M. Tulino
Registration No. 48,294

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 15, 2004